UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,706	08/19/2003	Catherine Joyce		5129

7590 11/02/2004

Catherine Joyce
P.O. Box 4314
Portsmouth, NH 03802

EXAMINER	
THOMPSON, CAMIE S	
ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/643,706	JOYCE, CATHERINE	
	Examiner	Art Unit	
	Camie S Thompson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-3 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The use of underlining and bracketing terms throughout the specification is improper. Please remove the bracketing and underlining.

Claim Objections

2. In claim 1, the phrase "in this invention" in line 2 is unnecessary language. The examiner suggests deleting the phrase.

3. In claim 1, the phrase "which are the subject of this invention" in line 10 is unnecessary language. The examiner suggests deleting the phrase.

4. In claim 3, there is a large separation from the comma and the term "wherein" in the first line of the claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or

use the invention. It is not disclosed as to what Pseudo-Fiber™ Natural Fiber, Type A, Type B or other family members are referring to and have no recognized meaning. One of ordinary skill in the art would not be able to make and/or use the instant invention, as applicant has not disclosed what the Pseudo-Fiber™ Natural Fiber is. The description does not disclose how to make the composite. It appears in some instances that the composite is made of fibers and some other material but it cannot be ascertained as to what the "layers" are or what the layers are made of. Further, the applicant refers to double or multi-ply layers and further refers to multiple layers. Multi-ply and multiple are synonymous. From the manner in which the claim is written, it appears there is a composite material made of waste material and a single layer and a double or multi-ply layers or multiple layers. This combination is not described in the specification. Also in claim 3, it cannot be ascertained what are the alternately "additionally layers not containing the composite material". What exactly might applicant be referring to? The specification offers no clue whatsoever. The specification offers no detailed description of what intermittently not containing and again, what the layers are made of when not containing waste material is not disclosed. It cannot be ascertained from the written description how the single layer is positioned as top, middle or bottom layer when it is only as single layer. This makes no sense. The multiple or multi-ply layer has not been defined. The terms have not been made distinguishable.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the trademark/trade name Pseudo-Fiber™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe fibers and, accordingly, the identification/description is indefinite.

In claim 1, the scope and nature of a single layer, double layer, multi-ply layer and multiple layers is confusing. A single layer cannot have a middle layer. Double or multiple layers cannot stand-alone.

Additionally, in claim 1, "selected from the group of waste materials" does not make sense because no group has been provided in the claim. The following phrase "which are the subject of this invention" does not define a group and should be removed.

Claim 2 is rendered indefinite because neither a sound attenuator nor impact modifiers can be used as additives. These terms are vague and confusing.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Price, U.S. Patent Number 3,671,615.

Price discloses a composite board product made from waste materials such as polymeric materials, wood shavings and fibrous materials that includes paper and paperboard as per instant claim1 (see column 1, lines 1-69). The waste materials of Price are unprocessed or uncooked and so meet the requirements of Pseudo-Fiber™. The reference also discloses that the composite material can be used to make single, double or multiple layer composites such as floor tiles, counter tops, wall panels and insulation or the composite can be used as a paperboard laminate as per instant claims 1 and 3 (see column 1, lines 28-69). In addition, the reference discloses using metallic foils and filler materials as per instant claims 2 and 3 (see column 1, lines 46-48). Although the reference does not include that the layers "may be joined by lamination, application of barrier layers …, is a process limitation in a product claim and is given little consideration. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. Further, the language "may be joined" does

not positively recite that the layer is joined. It only denotes that the layers could be joined and so is not a limitation considered in claim 3. The reference meets all of the requirements of the claims.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L Dye, can be reached at (571) 272-3186. The fax phone number for the Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RENA DYE
SUPERVISORY PATENT EXAMINER 10/3-4

A.U. 1774